

Serial No. **10/792,130**

Docket No. **K-0619**

Amendment dated **July 2, 2007**

Reply to Office Action of **April 2, 2007**

REMARKS/ARGUMENTS

Claims 1, 2, and 4-10 are pending. By this Amendment, claims 1, 4, 5 and 9 are amended.

Entry of the amended claims is proper under 37 C.F.R. §1.116 since the amendments: (1) place the application in condition for allowance (for the reasons discussed herein); (2) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution without incorporating additional subject matter); (3) satisfy a requirement of form asserted in the previous Office Action; and/or (4) place the application in better form for appeal (if necessary). Entry is thus requested.

In review, the Examiner noted an informality in Claim 1 and this has been corrected by the amendment thereto.

Secondly, claims 1, 2, 4, and 6-10 are rejected under 25 U.S.C. §103(a) over Shi et al. (U.S. Patent No. 5,972,247) in view of Enokida et al. (U.S. Patent No. 5,759,444). Claims 1, 2, and 4-9 stand rejected under 35 U.S.C. §103(a) over Hosokawa et al. (U.S. Patent No. 6,534,199).

Applicants respectfully traverse both rejections of the claims under 35 USC 103(a). The arguments in support of the traversals of the rejections are set out below under the headings of the applied prior art.

Serial No. **10/792,130**
Amendment dated **July 2, 2007**
Reply to Office Action of **April 2, 2007**

Docket No. **K-0619**

US Patent No. 5,972,247 to Shi et al. (Shi) and US Patent No. 5,759,444 to Enokida et al.

In maintaining the rejection based on Shi and Enokida, the Examiner contends that Shi teaches the host material when the claim is interpreted to specify anthracene as X and phenyl as B1 and B2.

In light of this contention, the host material of claim 1 is revised such that B1 and B2 are defined as aryl “except phenyl”. The more narrow definition of B1 and B2 in claim 3 is revised to be consistent with the exclusion of phenyl of claim 1. Claims 5, 9, and 10 that list specific formulas are also revised to ensure that they are consistent with the exclusion specified in claim 1.

Applicants contend that the revision to claim 1 is both supported by the original specification and does not raise a new issue requiring further consideration or search. Addressing the support issue first, it is true that any claim limitation must have a basis in the specification as originally filed to meet the standards of 35 U.S.C. § 112, first paragraph. However, the MPEP says in Section 2173.05(i) that a negative limitation does not require a literal basis in the specification to be supported by the original specification. Moreover, this MPEP Section points to MPEP Sections 2163 to 2163.07(b) and their analysis regarding an adequate written description for new matter issues.

Referring to MPEP Section 2163.02, the test for written description is “whether the description clearly allows persons of skill in the art to recognize that he or she invented what is

claimed.” It is asserted that the exclusion of phenyl is proper as since Applicants are entitled to narrow their claims, just as is it permissible to close the claims using the terms “consisting essentially of” and “consisting of.” It can be reasonably said that the inventors had in their possession at the time of the invention the ability to exclude one or more species if so desired. Thus, the change to claim 1 does not raise an issue of new matter.

Secondly and referring to the amendment after a final rejection, it is asserted that the Examiner has already joined the issue of whether the prior art disclosed phenyl as the claimed aryl. The revisions to the claim that deal with the excepting phenyl do not raise a new issue requiring further search or consideration. Since the Examiner has already faced the question of whether the claims can be rejected if they can be interpreted not to exclude “phenyl,” the issue of whether the claims cannot be rejected if “phenyl” is excepted or excluded from the claims was also implicitly before the Examiner prior to this amendment. Expressly claiming this exclusion does not raise a new issue that would prevent entry of this amendment.

On the assumption that this amendment is proper for entry, the question of patentability is resolved by the change to claim 1. The exception of “phenyl” makes it abundantly clear that the rejection based on Shi is now overcome and this amendment should be entered to advance the prosecution of this application.

To reiterate, the only basis for the rejection was the contention that when X is interpreted to be anthracene and B1 or B2 is interpreted to be phenyl, Shi can be relied upon to allege that

the claimed host material is taught. However, with the change to claim 1, the Patent Office cannot take the position that Shi teaches or suggests claim 1 in its present state of revision. Since Shi does not teach the claimed host limitation, it cannot form the basis for a rejection under 35 U.S.C. § 103(a).

In addition, there is no reason to modify Shi so as to arrive at the claimed host material without exercising hindsight. Since the application of hindsight cannot form the basis of a rejection under 35 U.S.C. § 103(a), a further rejection of claim 1 is unwarranted.

Enokida is cited against the dopant aspect of claim 1 not the host material. Therefore, even if Enokida were combined with Shi, the device of claim 1, including the now-limited host material, would still not be taught.

In light of the above, the Examiner cannot rely on Shi and Enokida to establish the obviousness of claim 1 and it and its dependent claims are now patentable thereover.

Applicants also wish to argue that the Examiner has not made a *prima facie* case of obviousness against claim 2. In the rejection, the Examiner does not specifically identify a basis for asserting that Shi and/or Enokida discloses that the dopant or chemical formula 1 can have the claimed weight percentage of the light emitting layer. In fact, Shi only suggests that a dopant can be used in col. 20, lines 36-46, but does not disclose any preferred amounts. While the Examiner cites Enokida for the contention that the dopant of chemical formula 1 is known, the Examiner has not met the PTO burden of showing that the claim limitations of claim 2 are

Serial No. 10/792,130

Docket No. K-0619

Amendment dated July 2, 2007

Reply to Office Action of April 2, 2007

found in the prior art. Lacking an objective basis for asserting that claim 2 is disclosed in the combination of Shi and Enokida, claim 2 is not properly rejected and is thus allowable over the applied prior art.

US Patent No. 6,534,199 to Hosokawa et al.

The rejection based on rejection Hosokawa et al. (Hosokawa) is overcome for the same reasons laid out above for the rejection based on Shi and Enokida. In the rejection and as with Shi, the Examiner asserted that reading the host material with X as anthracene and B1 and B2 as phenyl meant that Hosokawa anticipates the claims.

This stance of anticipation is overcome by excepting phenyl from the claims and the rejection in this regard is overcome.

There is no question of obviousness remaining since Hosokawa provides no basis for asserting that the claimed host material could be derived from its teachings. Any such contention would be the use of Applicants' disclosure as a teaching template and this is not permitted when formulating a rejection under 35 U.S.C. § 103(a).

Applicants also reiterate that the change to claim 1 does not raise a new issue since the issue of the presence of phenyl has already been brought to the forefront by the Patent Office, and addressed fully in this response. Therefore, there is no reason why this Amendment cannot be considered at this time since it clearly overcomes Hosokawa from an anticipatory and

Serial No. **10/792,130**

Docket No. **K-0619**

Amendment dated **July 2, 2007**

Reply to Office Action of **April 2, 2007**

obviousness standpoint. Thus, the rejection based on 35 U.S.C. § 102(b) and Hosokawa as applied to claim 1 and its dependent claims must be withdrawn.

Applicants also wish to argue that the Examiner has not made a *prima facie* case of obviousness against claim 2. In the rejection, the Examiner does not specifically identify a basis for asserting that Hosokawa discloses that the dopant or chemical formula 1 can have the claimed weight percentage of the light emitting layer. Lacking the identification of such a basis in the rejection, the Examiner has not met the PTO burden of showing that the claim limitations of claim 2 are found in the prior art. Lacking an objective basis for asserting that claim 2 is disclosed in Hosokawa, claim 2 is not properly rejected and is thus allowable over the applied prior art.

CONCLUSION

In light of the revisions to claims 1, 3, 5 and 9, Applicants have clearly overcome the two prior art rejections. In addition, the rejection of claim 2 is flawed for the reasons set out above, and this claim stands on its own for patentability.

Moreover, since the issue of patentability, i.e., the presence of phenyl with the anthracene of each of Shi and Hosokawa, was already addressed by the Patent Office, its exception as part of this Amendment does not raise a new issue that would enable the entry of this Amendment to be denied.

Serial No. **10/792,130**
Amendment dated **July 2, 2007**
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Docket No. **K-0619**

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Daniel Y.J. Kim**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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